



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,354	10/20/2003	Hisao Okaniwa	F-8001	4211

28107 7590 04/10/2006

JORDAN AND HAMBURG LLP  
122 EAST 42ND STREET  
SUITE 4000  
NEW YORK, NY 10168

EXAMINER
----------

PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
----------	--------------

3724

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/689,354	Applicant(s) OKANIWA, HISAO	
	Examiner Kenneth E. Peterson	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 and 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 10-12 and 14-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 28 March 06.
2. Figures 12-14 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
3. Claims 1 and 13 are objected to because of the following informalities:  
  
On line 2 of claim 1, an "a" is needed before "cutter".  
  
On line 2 of claim 13, "both bristles" lacks proper antecedent basis.  
  
Appropriate correction is required.
4. Claims 2,4,6,9 and 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the phrase “the cutting edge of said cutter is disposed opposite the bristles” is of unclear scope and meaning. What constitutes “opposite” in this situation? How could one cutting edge be opposite plural bristles?

In claim 4, the phrase “the cutting edge of said cutter is disposed so as to face the adjacent bristles. A cutting edge is a one-dimensional line, and has no face. Thus it is not clear what would or would not be “facing” the cutting edge.

In claim 6, the phrase “the height of the cutting edge of said cutter is roughly equal to the height of the bristles”. This contradicts the previous claim and the specification and the drawings, which clearly show the cutting edge is shorter than the bristles. Accordingly, it is not clear what scope should be given to this incongruent language.

In claim 9, the cover has an “approximately U-shaped cross section”. Given the complex shape of the guard 18b as seen in figure 2, the use of the term “U-shaped cross section” is an over-simplification that makes the claim of unclear scope. Furthermore, it is not clear at what angle or level this cross section is being taken.

In claim 13, the phrase “both bristles serving as holding members for the cutters, on which the cutters are mounted” is not understood. How is it that the cutters are mounted on both bristles. Furthermore, only one cutter was previously recited.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3724

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art.

On page 2 of Applicant's specification, and in Applicant's figures 12-14, Applicant shows a piece of admitted prior art based on a Japanese Publication S51-9966.

This admitted prior art shows all of the recited features as follows;

In regards to claims 1 and 3, the cutter (76) is "upright" as opposed to laying down.

In regards to claims 2,4 and 13, as not understood, the cutting edges "oppose" or "face" the bristles to an extent similar to Applicant's.

In regards to claims 5 and 6, as not understood, the blades are shorter than the bristles, but roughly equal.

In regards to claim 7, some of the bristles diverge from the cutting edges as seen in figure 13.

In regards to claim 8, the bristles appear to be circular.

7. Claims 1-5,7,8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Laughlin. See figure 5, blade 22 with cutting edges 24. This tool is capable of being employed to brush hair (be careful!).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3724

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable.

The admitted prior art, as employed above, lacks a U-shaped cover over the cutting edges. Examiner takes Official Notice that it is old and well known to employ U-shaped guards over similar cutting edges. Examples of this are the patents to Halaby, Michelson and Bresler. Additional examples can be provided if needed. It would have been obvious to one of ordinary skill in the art to have provided a U-shaped guard on the admitted prior art, as is well known and taught by Halaby, Michelson and Bresler, in order to limit the depth of cutting and prevent injury.

10. Made of record but not relied on is a patent to Talavera showing a pertinent brush.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached Mon-Thurs, 7:30AM-5PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KP

March 23, 2006



KENNETH E. PETERSON  
PRIMARY EXAMINER